

REMARKS

The Examiner's courtesy and assistance during Applicant's telephone call on September 2, 2004 is gratefully acknowledged.

Claims 1 through 11 are pending in the application. Claims 5, 6, 7, and 10 are amended above.

In the Office Action, claims 1 through 11 were rejected as being unpatentable over U.S. Patent No. 6,609,106 ("Robertson") in view of U.S. Patent No. 5,809,479 to Martin et al. ("Martin").

The Office Action acknowledges that Robertson fails to disclose "filling at least two orders over a predetermined period of time by delivering the perishable goods to the prospective recipient on at least two different days." Then, the Office Action states that "Martin teaches customers specifying early and late delivery limits which specify on-time windows relative to delivery dates which are requested or expected by the individual customers." The Office Action then concludes that "it would have been obvious to modify the method of Robertson to include early and late delivery date limits as taught by Martin."

The Applicant respectfully challenges this reasoning. Firstly, Applicant notes that Martin relates to entirely different subject matter than that of the present invention. Martin relates to so-called "just-in-time" supply arrangements, whereby purchasers with regular and ongoing requirements for goods can ensure timely, periodic delivery of those goods on an as-needed basis, so as to minimize the overhead associated with storage of large inventories of goods. As such, Martin relates exclusively to simple two-party purchase-and-sale transactions involving a customer and a supplier. The customer places orders with the supplier, and the supplier ships goods to the customer.

The Applicant's invention, on the other hand, relates to gifting transactions involving *three* parties – a prospective recipient, a seller of goods, and a gift-giver. The prospective recipient registers with the seller, the gift-giver indicates a desire to have a gift sent to the prospective recipient, and the seller delivers the gift to the prospective recipient.

Given the dissimilarity between the types of transactions described in Martin as compared with the types of transactions in this application (and in Roberston), the Applicant questions whether there is any basis for concluding in the first place that a person of ordinary skill could be expected to combine Robertson and Martin. It is the Applicant's understanding that the Examiner has a duty to show that there would be some motivation for a person to combine references relied on in rejecting claims in an application. "First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." M.P.E.P. § 706.02(j).

In this case, no such showing has been made, despite the fact that the two references cited relate to very different subject matter. Rather, it appears to the Applicant that the Office Action relies on the benefit of hindsight to "cherry-pick" from the prior art to assemble a combination of references alleged to resemble the present invention. This is not allowed: "The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention." M.P.E.P. § 2141.

In addition, even if one assumes that the combination of Robertson and Martin was considered, it is not at all clear that the result of that combination would achieve the same result as the present invention. That is, it does not appear that the Office Action establishes the "reasonable expectation of success" that is required of a proposed combination of references. See, M.P.E.P. § 706.02(j). Since the transactions described in Martin involve fewer participants than those in Robertson, it is difficult to imagine how these references could be combined in the first place. Applying Martin to Robertson, one must ask: Is it the gift-giver or the prospective recipient who specifies a preferred receipt date or date window? To conclude that the answer to this question is "the prospective recipient" would once again amount to hindsight reconstruction of the prior art, as Martin provides no guidance in this regard. "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure." M.P.E.P. 706.02(j).

In view of the foregoing remarks, it is respectfully submitted that the § 103 rejections of the claims are improper. Reconsideration and withdrawal of those rejections is requested.

The Applicant has amended the specification to address the objection to the drawings. Further, the Applicant has amended the claims in the application to address the rejections under 35 U.S.C. § 112 relating to the references to "recipients" (plural) instead of "recipient" (singular). No new matter is added by way of these amendments. Consequently, the Applicant believes that the claims should be allowable.

If the Examiner believes that additional or alternative amendments might place the application in better condition for allowance, he is invited to contact the Applicant directly at (713) 444-2483.

Respectfully submitted,



Zackery Alolabi
710 Briar Hill Drive
Houston, Texas 77042